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| 10/625,006 | 07/23/2003 | Masanori Kawai | 04995/107001 | 8437 |
| Jonathan P. Osha ROSENTHAL & OSHA L.L.P. Suite 2800 1221 McKinney St. Houston, TX 77010 | | | | |
| EXAMINER | | | | |
| STOKELY-COLLINS, JASMINE N | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,006

Applicant(s)

KAWAI, MASANORI

Examiner

JASMINE STOKELY-COLLINS

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.
2. In applicant's remarks, pages 5-6, applicant argues that Takashimizu, Lett, and Potrebic in view of Goldstein does not result in "if the selected channel is not included in the favorite channel map, the control section does not start recording the selected channel against the operation to the apparatus except the selected channel is not changed over a predetermined time." The examiner's previous rejection was based on selection of the channel *to be recorded*, and therefore does not address the situation where the channel is selected *to be viewed*.
3. However, Potrebic teaches tuning to a channel for viewing (col 5 ll. 45-46, block 502), where the channel being viewed can be recorded (see col. 9 47-49, block 508). There is only one disk drive for recording television programming (fig. 4, disk drive 408), therefore only one recording event can occur at a time. Potrebic teaches changing to a new channel for viewing, however he does not teach a mechanism for allowing the new channel to be recorded in the case that a user intends so. Potrebic attempts to record only the desired programming of a user, but lacks criteria for determining channels that a user would wish to record other than it being the initial channel tuned to during recording. It is known in the art that users often wish to record favorite, or frequently watched channels; for example, in related art, Goldstein teaches a remote control that interacts with recording devices, television receivers, and other remotely controllable devices (such as those taught in Potrebic) to incorporate additional features which

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would be useful to a user of these appliances. Goldstein's recording device interaction includes further criteria that would indicate a user's desire to simultaneously watch and record programming (col. 26 ll. 54-56), namely if the channel is a favorite channel or if it is frequently watched. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Potrebic's criteria for deciding if a user wants to record a channel by adding the above stated criteria for the benefit of broadening the number of scenarios in which recording may be intended and thus not hindering a user's ability to record any intended television programming. Therefore, Potrebic's recording device would have criteria to decide whether a user changed channels with the intention to record the newly viewed channel.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashimizu et al (US 2005/0152686 A1) in view of Lett (US 5,592,551) and Potrebic (US 6,897,904 B2), and further in view of Goldstein (US 5,410,326).

Regarding claim 1, Takashimizu teaches a digital broadcast receiving and recording apparatus (figure 1) comprising:

a receiving section (figure 1 element 300: antenna) adapted to receive a digital broadcast signal of a selected channel (page 1 section 0005);
a digital data generating section adapted to generate digital data from the digital broadcast signal (pages 2-3 sections 0031-0032);
a recording section adapted to record the digital data in a predetermined format and to sequentially output the recorded digital data (page 3 section 0038); and
a control section (figure 1 element 409: control means).

Takashimizu does not teach a storage section adapted to store a favorite channel map indicating a favorite channel of a viewer; and
the control section is adapted to control the recording section to start recording the selected channel according to an operation for selecting a channel by a user, and to generate an EPG image of the favorite channel based on the favorite channel map, and
wherein if the selected channel is not included in the favorite channel map, the control section does not start recording the selected channel against the operation to the apparatus by a user except the selected channel is not changed over a predetermined time from a time selected.

Lett teaches a storage section adapted to store a favorite channel map indicating a favorite channel of a viewer (figure 11); and
to generate an EPG image of a favorite channel based on a favorite channel map (column 15 lines19-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lett's favorite channel map

and favorite channel EPG with the claimed invention in for the benefit of having a smaller guide that is quicker and easier for viewers (column 15 lines 27-28) to navigate.

Takashimizu in view of Lett does not teach the control section is adapted to control the recording section to start recording the selected channel according to an operation for selecting a channel by a user, and to generate an EPG image of the favorite channel based on the favorite channel map, and wherein if the selected channel is not included in the favorite channel map, the control section does not start recording the selected channel against the operation to the apparatus by a user except the selected channel is not changed over a predetermined time from a time selected.

Potrebic teaches a control section (figure 4 element 406: tuner controller) adapted to control the recording section to start recording the selected channel according to an operation for selecting a channel to be viewed (column 5 lines 2-5 and lines 22-24) wherein the control section does not start recording the selected channel against the operation to the apparatus (figure 5 and column 5 lines 42-63 teaches using a different tuner for the newly selected channel so that recording continues on the previous channel and does not carry over to the new channel). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the invention of Potrebic with the teachings of Takashimizu in view of Lett for the benefit of allowing a user to record a

program while adding the ability to view other programming during that recording process.

Potrebic, either taken separately or combined with Takashimizu in view of Lett, does not teach a mechanism for allowing the new channel to be recorded in the case that a user intends so.

In related art, Goldstein teaches a remote control that interacts with recording devices, television receivers, and other remotely controllable devices (such as those taught in Potrebic) to incorporate additional features which would be useful to a user of these appliances. Goldstein's recording device interaction includes further criteria that would indicate a user's desire to simultaneously watch and record programming (col. 26 ll. 54-56), namely if the channel is a favorite channel or if it is frequently watched . It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Potrebic's criteria for deciding if a user wants to record a channel by adding the above stated criteria for the benefit of broadening the number of scenarios in which recording may be intended and thus not hindering a user's ability to record any intended television programming. Therefore, Potrebic's recording device would have criteria to decide whether a user changed channels with the intention to record the newly viewed channel (i.e. "if the selected channel to be viewed is not included in the favorite channel map, the control section does not start recording the selected channel against the operation to the apparatus by a user

except the selected channel is not changed over a predetermined time from a time selected").

Regarding claim 2, see analysis of claim 1.

Regarding claim 3, see analysis of claim 1.

Regarding claim 4, see analysis of claim 1.

Regarding claim 5, Takashimizu in view of Lett and Goldstein discloses the apparatus of claim 2. Takashimizu further teaches an output section (figure 1 element 406: video encoder) adapted to convert the digital data into analog data and to output the analog data (page 3 section 0032). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a means for converting digital data into analog for the benefit of allowing an analog television to receive digital signals.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yoshinobu (US 5,734,444) teaches recording frequently watched programs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASMINE STOKELY-COLLINS whose telephone number is (571) 270-3459. The examiner can normally be reached on M-Th 9:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jasmine Stokely-Collins/
Examiner, Art Unit 2623

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2623